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10/779,421	02/13/2004	Robert H. Wollenberg	T-6320 (538-66)	9070

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EXAMINER

GROSS, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1639

MAIL DATE	DELIVERY MODE
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07/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/779,421

Applicant(s)

WOLLENBERG, ROBERT H.

Examiner

Christopher M. Gross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 04 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/6/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Responsive to communications entered 5/4/2007. Claims 1-21,33-35 are pending. Claims 1-21,33-35 are under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Withdrawn Rejections

The rejection of claims 33-34 under 35 U.S.C. 102(b) as being anticipated by **Francisco et al** (US Patent 5,308,522) is hereby withdrawn in view of applicant's amendments to the claims.

The rejection of claims 33-34 under 35 U.S.C. 103(a) as being unpatentable over **Francisco et al** (US Patent 5,308,522) in view of **Chaffee et al** (US Patent 4,774,281) is hereby withdrawn in view of applicant's amendments to the claims.

Maintained Claim Rejection(s) - 35 USC § 102

Claims 1-3,5-9,21 are rejected under 35 U.S.C. 102(b) as being anticipated by **Francisco et al** (US Patent 5,308,522). Claims 1,2,4-5,8,10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by **Migdal et al** (US Patent 5,062,980).

Please note that the above rejections have been modified from the original version to more clearly address applicants' newly amended and/or added claims and/or arguments.

Response to Arguments

Applicant argues not all elements are taught.

Applicant's arguments have been fully considered but they are not deemed persuasive for the following reasons.

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Applicant argues, see pp 7-11 (5/4/2007) neither Francisco et al nor Migdal et al teach a high throughput method for screening lubricating oil compositions under program control.

In response to applicant's arguments, the recitations "high throughput" and "program control" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Maintained Claim Rejection(s) - 35 USC § 103

Claims 1-3,5-9,21, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Francisco et al** (US Patent 5,308,522) in view of **Chaffee et al** (US Patent 4,774,281).

Please note that the above rejection has been modified from the original version to more clearly address applicants' newly amended and/or added claims and/or arguments.

Response to Arguments

Applicant does not offer further arguments regarding the above obviousness rejections beyond what was set forth with regard to the 35 U.S.C. § 102 rejection. To

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the extent that Applicant is merely repeating their previous argument, the Examiner contends that those issues were adequately addressed in the above sections, which are incorporated in their entireties herein by reference.

Claims 1-3,5-9,21 and 11-14,17-20 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Francisco et al** (US Patent 5,308,522) in view of **Kolosov et al** (US Patent Application 2004/0123650 – IDS entry 2/126/2006)

Francisco et al is relied on as above and the last office action.

Francisco et al do not teach sample sizes no more than 10 ml (claim 14), the use of a robotic assembly (claim 17), control by a computer (claim 18), storing data (claims 19,33,35) or using the data of claim 1(c) for further calculations (claim 20).

Kolosov et al teach, throughout the document and especially figure 1 and paragraph 0068 the use of a robot which is controlled by a computer to screen and analyze a library of material samples.

Kolosov et al teach in and paragraph 0021 sample sizes as small as 1 ml, which is in the range of claims 11-14.

It would have been *prima facie* obvious for one of ordinary skill in the art, at the time the claimed invention was made to use the computer controlled robot of Kolosov et al with the elastomer testing protocol of Francisco et al.

One of ordinary skill in the art would have been motivated to use the computer controlled robot of Kolosov et al with the elastomer testing protocol of Francisco et al because of the need to reduce time in analyzing samples and it would be especially

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attractive to rapidly test a plurality of samples on a common substrate, as noted by Kolosov et al in paragraph 0005.

One of ordinary skill in the art would have had a reasonable expectation of success in combining the computer controlled robot of Kolosov et al with the elastomer testing protocol of Francisco et al because Kolosov et al has applied the computer controlled robot toward rheological studies (e.g. viscosity or elasticity). Therefore it would not have been unreasonable to apply the computer controlled robot as part of the method of Francisco et al because tensile strength is directly related to elasticity.

Please note that the above rejection has been modified from the original version to more clearly address applicants' newly amended and/or added claims and/or arguments.

Response to Arguments

Applicant argues, see p13 (5/4/2007), first full paragraph, lines 13-14 that the Examiner has used the present disclosure as a guide to piece together the claimed invention.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned *only* from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The motivation to combine the method of testing of lubricating oil plus stress activated load additives per Francisco et al with the automation afforded by Kolosov et al lies in the attractiveness of rapidly testing a plurality of samples quickly, which is taken from Kosolov et al in paragraph 0005 and *not* taken from instant specification.

Maintained Claim Rejection(s) – Double Patenting

Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,137,289 in view of Francisco et al (US Patent 5,308,522) and further view of Bailey et al (US Patent 3,108,397)

Claims 1-3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 11/528747 in view of Bailey et al (US Patent 3,108,397).

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/699510 in view of Francisco et al (US Patent 5,308,522).

Claims 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of each of copending Application Nos. 11/605127, 10/699508, 10/699507, 10/779422 in view of Francisco et al (US Patent 5,308,522) and Guninther et al (US Patent Application 2004/0074452).

Response to Arguments

Applicant does not offer arguments regarding the above double patenting rejections, however applicant will consider filing a terminal disclaimer upon resolution of the other issues mentioned above.

Until such time that said terminal disclaimer(s) is(are) filed, the above double patenting rejections will be maintained.

New Claim Rejection(s) – 35 USC § 112

The following is a quotation of the **first** paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. 37 CFR 1.118 (a) states that "No amendment shall introduce new matter into the disclosure of an application after the filing date of the application".

This rejection is necessitated by Applicant's amendment to the claims.

Claim 33 has been amended such that compatibility data [is] stored on a programmed controller. It is noted that paragraph 0071 of the published application, however, is drawn to: "elastomer compatibility is programmed into the computer

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controller for 'pass/fail' determination" which is considerably narrower (i.e. merely compatible or incompatible) rather than [generically] storing elastomer compatability data, which reads on a broad range of numerical values (i.e. mm, cm, etc), qualitative criteria, etc concerning elastomer elongation, for instance.

Applicants are reminded that it is their burden to show where the specification supports any amendments to the claims. See 37 CFR 1.121 (b)(2)(iii), the MPEP 714.02, 3rd paragraph, last sentence and also the MPEP 2163.07, last sentence.

MPEP 2163.06 notes "If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)." MPEP 2163.02 teaches that "Whenever the issue arises, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed...If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application. MPEP 2163.06 further notes "When an amendment is filed in reply to an objection or rejection based on 35 U.S.C. 112, first paragraph, a study of the entire application is often necessary to determine whether or not "new matter" is involved. *Applicant should therefore specifically point out the support for any amendments made to the disclosure.*

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Gross whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Douglas Schultz can be reached on 571 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M Gross
Examiner
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/Jon D. Epperson/
Primary Examiner, AU 1639